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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,677

06/15/2005

Hiroshi Hirai

2005\_0629A

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03/21/2006

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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/532,677

Applicant(s)

HIRAI ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005 (Pre. Amdt).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Applicant's preliminary amendment of 4-26-05 is acknowledged and entered.

Claims 17 and 18 have been added. Thus, claims 1-18 are pending.

#### *Claim Rejections - 35 USC § 112, Second Paragraph*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-12 and 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. Claim 1 recites moieties or groups within parentheses, which is not clear if they are limitations or explanation.
- b. Variables  $B_{n-1}$  and  $B_n$  do not appear to have a relationship with the formula. It appears that  $B_3 - B_6$  are intended. Applicant is suggested to use variables  $B_3 - B_6$  for consistency.
- c. Variables  $B_i$ ,  $B_{i+1}$ , and  $B_{i+2}$  do not appear to have relationship with the formula.
- d. The limitation of "when  $B_1, B_2 \dots$  are independently C, then  $B'_1, B'_2$  are oxo, respectively" seems to suggest a series of carbonyl groups (i.e.,  $-C(=O)-C(=O)-C(=O)-$ , etc.) which appear to be not stable for the intended ring structure.

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e. As drawn the encircled B suggests a ring; however, the definition of B includes aliphatic chain as well. Thus, the drawn formula is somewhat inconsistent with the compound intended.

f. Claims 15 and 16 are inconsistent because they seem to claim a compound but recite "pharmaceutically acceptable carrier or diluent" which suggests a composition.

g. Claims 2-12 and 14-18 are rejected as being dependent on claim 1, and carrying over the indefinite limitations.

***Claim Rejections - 35 USC § 112, First Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Written Description:** Claims 1-12 and 14-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation of "when B<sub>1</sub>, B<sub>2</sub> ... are independently C, then B'<sub>1</sub>, B'<sub>2</sub> are oxo, respectively" seems to suggest a series of carbonyl groups (i.e., -C(=O)-C(=O)-C(=O)-, etc.). The specification does not describe a process of making a compound with a series of carbonyl

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groups generically or in any example. Thus, the specification fails to provide adequate description for such a compound.


***Claim Objections***

3. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 13 recites species of substituted *indazolinone-quinoxalinone* and species of substituted *benzothiazolone-quinoxalinone* which are not taught or fully suggested by the prior art of record.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (9:30-6:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tamthom N. Truong  
Examiner  
Art Unit 1624

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3-13-06

  
JAMES O. WILSON  
SUPERVISORY PATENT EXAMINER  
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